

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

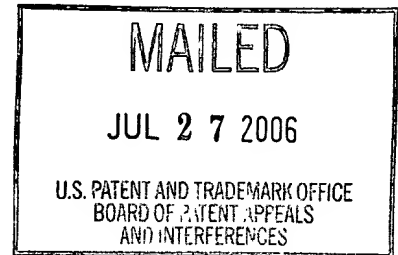
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte ALEXANDER S. TUZHILIN, and RAVINARAYAN ARUNKUNDRAM

Appeal No. 2006-1835
Application No. 09/013,490

HEARD: JULY 11, 2006



Before HAIRSTON, RUGGIERO and MACDONALD, Administrative Patent Judges.

MACDONALD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 38, 39, 41-59, and 61-88. Claims 1-37, 40, and 60, have been canceled.

Invention

Appellants' invention relates to an apparatus, method, and software arrangement for monitoring and searching a network, such as the Internet. The invention (1) periodically monitors for user defined conditions, including relationships amongst one or more network sites, (2) probes for further information upon detection of such conditions and (3)

automatically reports results to the user. Appellants' specification at page 3, lines 5-10.

Claims 52, 58, and 86 are representative of the claimed invention and are reproduced as follows:

52. An apparatus for monitoring information on a network, comprising:

a storage device storing a predefined criterion, and having a monitoring module thereon; and

a processing device executing the monitoring module to transmit at least one instruction to the network, the at least one instruction being executed on the network and requesting a performance of a monitoring operation to monitor the information on the network as a function of the predetermined criterion, the processing device is adapted to receive data from the network based on at least one result of the monitoring operation.

58. A method for monitoring information on a network, comprising:

receiving a predefined criterion;

monitoring the information on the network as a function of the predefined criterion, wherein the monitoring step being performed by executing at least one instruction on the network; and

receiving data from the network based on at least one result of the monitoring step.

86. An software arrangement for monitoring information on a network which is capable of being executed by a processor, comprising:

a program which, when executed by the processor, is capable of performing the following steps:

a) receiving a predefined criterion,

b) transmitting at least one instruction to the network,

c) monitoring the information on the network as a function of the predefined criterion, wherein the monitoring step being performed by executing the at least one instruction on the network, and

d) receiving data from the network based on at least one result of the monitoring step.

References

The references relied on by the Examiner are as follows:

Greenblatt et al. (Greenblatt)	5,809,238	September 15, 1998 (Filed Jun. 23, 1994)
Hunt et al. (Hunt)	5,893,091	April 6, 1999 (Filed Apr. 11, 1997)
Chadha et al. (Chadha)	6,134,555	October 17, 2000 (Filed Mar. 10, 1997)

Sistla et al. (Sistla); "Temporal Conditions and Integrity Constraints in Active Database Systems", ACM SIGMOD, Vol. 24, No. 2 (1995), pp. 269-280.

Rejections At Issue

Claims 38, 39, 41-43, 50-59, 61-63, and 70-88, stand rejected under 35 U.S.C. § 102 as being anticipated by Greenblatt.

Claims 44 and 64 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Greenblatt and Chadha.

Claims 45-47 and 65-67 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Greenblatt and Hunt.

Claims 48, 49, 68, and 69, stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Greenblatt, Hunt, and Sistla.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated infra, we affirm the Examiner's rejection of claims 38, 39, 41-43, 50-59, 61-63, and 70-88, under 35 U.S.C. § 102; and we affirm the Examiner's rejection of claims 44-49 and 64-69 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal the claims stand or fall together in ten groupings:

Claims 38, 39, 41, 50-52, 54, 56, 58, 59, 61, 70-72, 74, 78, and 80-88 as Group I;

Claims 42 and 62, as Group II;

Claims 43 and 63, as Group III;

Claims 53 and 73, as Group IV;

Claims 55 and 75, as Group V;

Claims 57 and 77, as Group VI;

¹ Appellants filed an appeal brief on April 24, 2003. The Examiner mailed a first Examiner's Answer on July 16, 2003. Appellants filed a second reply brief (the reply hereinafter) on December 15, 2003, replacing a defective first reply brief filed September 17, 2003. The Examiner mailed a second Examiner's Answer (the answer hereinafter) on September 19, 2005, duplicating the first answer except as to the signature page and fully replacing the first answer. Appellants filed a third reply brief on November 25, 2005, duplicating the arguments section of the second reply brief. In this decision we do not specifically address the duplicate arguments of the third reply as they are fully addressed by our discussion of the second reply.

Appeal No. 2006-1835
Application No. 09/013,490

Claims 84 and 85, as Group VII;

Claims 44 and 64, as Group VIII;

Claims 45-47 and 65-67, as Group IX; and

Claims 48, 49, 68, and 69, as Group X.

See pages 6-7 of the brief. We will, thereby, consider Appellants' claims as standing or falling together in the ten groups noted above with the exception that claim 56 (listed with Group I above) will be treated with Group V as it depends from claim 55, and we will treat:

Claim 38 as a representative claim of Group I;

Claim 42 as a representative claim of Group II;

Claim 43 as a representative claim of Group III;

Claim 53 as a representative claim of Group IV

Claim 55 as a representative claim of Group V;

Claim 57 as a representative claim of Group VI;

Claim 84 as a representative claim of Group VII;

Claim 44 as a representative claim of Group VIII;

Claim 45 as a representative claim of Group IX; and

Claim 48 as a representative claim of Group X.

Claim 76 (not listed with any group by Appellants) will be treated with Group V as it depends from claim 75.

I. Whether the Rejection of Claims 38, 39, 41, 50-52, 54, 58, 59, 61, 70-72, 74, 78, and 80-88 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Greenblatt does fully meet the invention as recited in claims 38, 39, 41, 50-52, 54, 58, 59, 61, 70-72, 74, 78, and 80-88. Accordingly, we affirm.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 38, Appellants at page 15 of the brief cite column 10, lines 7-10 of Greenblatt and argue, “the determination and monitoring of data is performed on the filter 36 of the DataServer 14 of the Greenblatt Patent, and not on the network.” Appellants at page 16, further argue that thus the testing of the data only occurs after the data is received at the Data Server 14. We disagree. Although Greenblatt teaches the filter performs the function argued by Appellants, Greenblatt also teaches alternatives at lines 31-44 of column 10 where the functions of the filter 36 are performed by or inherent to the probe and are thus performed “on the network.”

Appellants also argue at page 15 that “the Greenblatt Patent nowhere mentions that any monitoring or determination can be performed by executing at least one instruction on the network.” We disagree. Greenblatt specifically teaches the data probe may be an “agent” (col. 5, line 45). As Appellants’ own specification recognizes, an agent is a software program

that includes instructions. Further, Greenblatt describes the “DataProbe 16 communicates with networked platform P1 via transport network 12 to initiate a data collection application (resident within DataProbe 16 or on networked platform P1).” An “application” is a software program that includes instructions.

Appellants further argue in the reply at page 4, “the *mere operation of data collection* cannot be equated to the monitoring operation as recited in [claim 38].” Appellants go on to point out that monitoring requires “the data is watched, observed or checked.” We agree and Greenblatt teaches such monitoring at column 10, lines 36-39, where probes “may be preprogrammed to perform the event testing before data is returned to DataServer 14.” This meets the claimed monitoring (i.e., checking) and returning results.

Appellants also argue in the reply at page 6 that the DataServer 14 “does not receive the results based on the monitoring operation.” We disagree and again note that Greenblatt teaches such at column 10, lines 36-39.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 42 and 62 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Greenblatt does fully meet the invention as recited in claims 42 and 62. Accordingly, we affirm.

With respect to claim 42, Appellants argue at page 19 of the brief, “[Greenblatt] does not monitor both the event(s) and the condition, which is clearly contrary to the recitations of

[the claim].” Appellants at page 7 of the reply “assert that the events and the conditions recited in [the claims] are separate and distinct, and no associations are provided therebetween in the claims.” We disagree. Nothing in the language of claim 42 requires “separate and distinct” as asserted by Appellants. Additionally, Appellants’ own specification at page 12 states that conditions “are constraints that the user applies to events and act as filters that refine the space of the events to result in a smaller subset, that are of interest to the user.” By Appellants’ own definition, an association therebetween is required. Since, as pointed out by the Examiner in the rejection, Greenblatt monitors both the event and the constraint to check if a condition is present, this meets the claim.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 102.

III. Whether the Rejection of Claims 43 and 63 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Greenblatt does fully meet the invention as recited in claims 43 and 63. Accordingly, we affirm.

With respect to claim 43, Appellants argue at page 20 of the brief, “[Greenblatt] in no way teaches or suggests, much less discloses the subject matter recited in claims 43 and 63.” We disagree. Greenblatt at columns 7 and 8 explicitly states that nested events can be of the form where “the inquiry statement may request that data A be returned when data B is determined to have achieved a predicate test associated with data B.” (Col. 7, lines 41-43). Greenblatt then goes on to discuss two alternatives where (1) the probe collects data A and

data B together (the THEN portion probing action to get data A would be against already collected data rather than the network) and (2) a probe collects data A only after data B achieves the test (the THEN portion probing action to get data A would be against the network as claimed). See column 8, lines 31-34. This corresponds to the two disclosed alternatives at pages 36-37 of Appellants' specification where, if a condition is satisfied, then either (1) a search is performed at the monitoring site (off network) against already retrieved data or (2) other probing is performed on the network to return the information.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

IV. Whether the Rejection of Claims 53 and 73 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Greenblatt does fully meet the invention as recited in claims 53 and 73. Accordingly, we affirm.

With respect to claim 53, Appellants apparently argue at page 21 of the brief, that "[Greenblatt] does not provide any result that includes a copy of a portion of the monitored predicate" as claimed. As we discussed above with respect to claim 38, Greenblatt teaches such monitoring at column 10, lines 36-39.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

V. Whether the Rejection of Claims 55, 56, 75, and 76 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Greenblatt does fully meet the invention as recited in claims 55, 56, 75, and 76. Accordingly, we affirm.

With respect to claim 55, Appellants argue at pages 22-23 of the brief, “[Greenblatt] does not even mention, much less disclose that the event includes an atomic event and/or a combination of events.” We disagree.

As the Examiner correctly points out, figure 6 of Greenblatt teaches that an (OVERLOAD) event is a conjunction of two events (CPU_BUSY) and (PAGE_BUSY). Appellants point to no evidence to show that each of the two events are-not atomic and Appellants’ own definition of combination at page 14 of the specification is that a composite event “is the conjunction of two or more atomic events.”

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 102.

VI. Whether the Rejection of Claims 57 and 77 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Greenblatt does fully meet the invention as recited in claims 57 and 77. Accordingly, we affirm.

With respect to claim 57, Appellants argue at page 24 of the brief, “claims 57 and 77 includes “WHEN” clauses that are time dependent ... while the “WHERE” clauses of

[Greenblatt” are not time dependent.” The Examiner rebuts this argument pointing out that Appellants’ assertion is misplaced as there is no “WHERE” clause in the cited portion of Greenblatt, and Greenblatt’s “WHEN” is constructed through the use of events and predicates. Appellants do not counter this rebuttal in the reply. We further note that Appellants’ specification at page 12 does not include any time dependency in its definition of the “WHEN” clause nor is an explicit time dependency found in claim 57.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 102.

VII. Whether the Rejection of Claims 84 and 85 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Greenblatt does fully meet the invention as recited in claims 84 and 85. Accordingly, we affirm.

With respect to dependent claim 84, Appellants merely restate the “on the network” argument presented with respect to claim 38. We have found that argument to be unpersuasive. Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 102 for the same reasons as set forth above with respect to claim 38.

VIII. Whether the Rejection of Claims 44 and 64 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 44 and 64. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. See also Piasecki, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to dependent claim 44, Appellants assert at page 26 of the brief, “there is absolutely no teaching or suggestion in [the cited] portions of the Chadha Patent or in any other section thereof of the probing operator which includes a data mining query.” We disagree. Chadha clearly describes data mining against a database to retrieve data (col. 4, lines 24-26). Further, Appellants’ own specification at pages 39-46 discusses numerous prior art references that evidence the very high level of skill in this art. Given this evidence, nothing more than the teaching of Chadha is required to teach a “data mining query” as one skilled in the art would recognize Chadha to be inoperative without a data-mining query.

Appellants also argue that the Examiner’s rejection is flawed because “the Greenblatt patent provides absolutely no teaching, suggestion, motivation or incentive to utilize data mining techniques in its monitoring system.” We disagree. It is the Chadha patent that explicitly provides the motivation. Chadha states “[d]ata mining is the process of finding interesting patterns in data.” We find this to be sufficient motivation to utilize data mining techniques to find “interesting patterns” in the data of Greenblatt. Appellants have done nothing more than use known techniques for their intended purpose to achieve an entirely expected result.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

IX. Whether the Rejection of Claims 45-47 and 65-67 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 45-47 and 65-67. Accordingly, we affirm.

With respect to dependent claim 45, Appellants merely refer back to the argument presented with respect to claim 43. We have found that argument to be unpersuasive. Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above with respect to claim 43.

X. Whether the Rejection of Claims 48, 49, 68, and 69 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 48, 49, 68, and 69. Accordingly, we affirm.

With respect to dependent claim 48, Appellants argue that the statement of the rejection failed to include the Hunt patent. We disagree as the statement of the rejection in both the final rejection (Paper No. 29 at p. 10) and the Examiner's answer (p. 13) clearly include the Hunt patent. Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above with respect to claim 45.

Other Issues

Should there be further prosecution of these claims before the Examiner, we point out that claim 86 fails to recite any storage medium for the claimed “software arrangement.” On its face this raises issues under 35 U.S.C. § 101 and 35 U.S.C. § 112 as the claim is directed to disembodied software per se.

Also, we note that through a sequence of inadvertent amendments, current Claim 52 has been amended to remove the feature of claim 52 as originally filed. Thus, current claim 52 is identical to originally filed claim 38 that was rejected under 35 U.S.C. § 102 over the Hunt patent. Given Appellants amended originally filed claim 38 to avoid the Hunt patent, we find before us no explanation of how current claim 52 is patentable thereover.

Conclusion


In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claims 38, 39, 41-43, 50-59, 61-63, and 70-88; and we have sustained the rejection under 35 U.S.C. § 103 of claims 44-49 and 64-69.

Appeal No. 2006-1835
Application No. 09/013,490

No time period for taking any subsequent action in connection with this appeal may
be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED


KENNETH W. HAIRSTON
Administrative Patent Judge


JOSEPH F. RUGGIERO
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

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